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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,681	05/22/2002	Kalevi Ratschunas	4925-219PUS	2735

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,681

Applicant(s)

RATSCHUNAS ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 10, 11, 12, 14-17, 22, 23, 24-28, and 29-34 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,636,733 by Helferich.

Regarding claim 1, Helferich discloses a method for delivering messages in a network comprising at least one terminal device (Fig. 1; col. 3, lines 22-33; col. 5, lines 15-20), comprising: generating a message; setting a condition for receiving said message; deciding whether said message is to be received by a terminal device based on said condition; and transmitting said message to said terminal device based on deciding whether the message is to be received (col. 9, line 25 – col. 10, line 30).

Regarding claim 2, the method of claim 1, wherein Helferich further discloses said setting step is performed by a terminal device (col. 9, lines 57-60; col. 10, lines 5-7 and lines 17-22).

Regarding claim 3, the method of claim 1, wherein Helferich further discloses said condition is a location of said terminal device (col. 10, lines 22-26).

Regarding claim 4, the method of claim 1, wherein Helferich further discloses including information regarding said condition in an optional field of said message (col. 3, lines 28-33; col. 10, lines 17-26).

Regarding claim 5, the method of claim 1, wherein Helferich further discloses determining whether said terminal device is inactive or busy when said condition is not met (col. 9, lines 25-65).

Regarding claim 10, the method of claim 1, wherein Helferich further discloses said message is a multimedia message (col. 7, lines 56-67).

Regarding claim 11, the method of claim 1, wherein Helferich further discloses said network is a mobile network (Fig. 1, 14) and said terminal device is a mobile terminal device (Fig. 1, 10) (col. 3, lines 22-33; col. 5, lines 15-20).

Regarding claim 12, Helferich discloses a network system for delivering messages in a network (Fig. 1; col. 3, lines 22-33; col. 5, lines 15-20), comprising: a terminal device (Fig. 1, 10); and a message delivering device (col. 6, lines 2-4) comprising a deciding means configured to decide whether a message is to be received by said terminal device based on a condition for receiving said message, and a transmitting means configured to transmit said message to said terminal device based on said deciding means determining whether the message is to be received (col. 9, line 25 – col. 10, line 30).

Regarding claims 14-17, 22, and 23, please see the rejections of claims 2-5, 10, and 11 mentioned above, respectively, to reject the system in claims 14-17, 22, and 23.

Regarding claim 24, a report delivery condition setting device or email server (Fig. 1, 16), comprising: a setting means configured to set a condition for receiving a message by a

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terminal device (Fig. 1, 10); and a supplying means configured to supply said message including said condition to a message delivering device or message processor (Fig. 1, 18) (col. 7, lines 56-67; col. 9, line 25 – col. 10, line 30).

Regarding claims 25-28, please see the rejections of claims 3, 4, 10, and 11 mentioned above, respectively, to reject the report delivery condition setting device in claims 25-28.

Regarding claim 29, a message delivering device or message processor (Fig. 1, 18) configured to deliver in a network (Fig. 1) a message for which a condition for receiving said message by a terminal device (Fig. 1, 10) is set, comprising: a deciding means configured to decide whether said message is to be received by said terminal device based on said condition; and a transmitting means configured to transmit said message to said terminal device based on a result of said deciding means (col. 7, lines 56-67; col. 9, line 25 – col. 10, line 30).

Regarding claims 30-34, please see the rejections of claims 3-5, 10, and 11 mentioned above, respectively, to reject the message delivering device in claims 30-34.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-9 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helferich, as applied to claims 1 and 12 above, respectively, in view of U.S. Patent No. 6,289,223 by Mukherjee et al, hereinafter Mukherjee.

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Regarding claim 6, the method according to claim 1, wherein Helferich does not disclose deciding whether an originator of said message is permitted to receive a delivery report; and transmitting said delivery report to the originator of said message only when said originator of said message is permitted the delivery report.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract; col. 3, line 46 – col. 4, line 37). Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted (col. 6, lines 13-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Helferich to include the originator of said message is permitted to receive a delivery report as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission and there are no user restrictions in message delivery to a group of users based on interrogation of a multipoint user group database.

Regarding claim 7, the method of claim 6, wherein Mukherjee further discloses: storing a list of originators of messages, which are permitted to receive delivery reports, in a database (col. 6, lines 13-30).

Regarding claim 8, the method of claim 6, wherein Mukherjee further discloses: defining a group of users which are allowed to receive delivery reports; wherein whether the originator of

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said received message is a member of said group of users is determined during said deciding step (col. 6, lines 13-30).

Regarding claim 9, the method of claim 8, wherein Mukherjee further discloses: adding a group identifier identifying said group of users to said message (col. 3, line 46 – col. 4, line 37).

Regarding claims 18-21, please see the rejections of claims 6-9 mentioned above, respectively, to reject the system in claims 18-21.

5. Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helferich in view of Mukherjee.

Regarding claims 35-39, please see the rejections of claims (1 and 6 for claim 35), 7, 3, 10, and 11 mentioned above, respectively, to reject the terminal device in claims 35-39.

Response to Arguments

6. All claim objections and 35 U.S.C. 112 rejections cited in the Non-Final Office action filed on 11-17-2004 are withdrawn.

7. Applicant's arguments with respect to claims 1-12 and 14-39 have been considered but are moot in view of the new ground(s) of rejection.

8. Accordingly, this action is **FINAL**.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh
July 18, 2005



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